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REMARKS

This is a full and timely response to the non-final Official Action mailed August 25, 2006. Reconsideration of the application in light of the following remarks is respectfully requested.

Prosecution Summary:

An earlier non-final Office Action was issued in this case on April 10, 2006. Applicant responded to the non-final Action with an amendment of July 10, 2006. Even though the outstanding Office Action was non-final, the Examiner then inexplicably and erroneously issued an Advisory Action refusing entry to Applicant's July 10<sup>th</sup> amendment. When the error was pointed out, the Examiner issued the current non-final Office Action of August 25, 2006.

Unfortunately, the Office Action of August 25, 2006 was essentially an exact cut-and-paste of the earlier Action of April 10, 2006. The Action of August 25, 2006 *did not* take into account or respond in anyway to Applicant's amendment of July 10, 2006.

When Applicant brought this situation to the attention of the Examiner, the Examiner promised in a phone conference of August 30, 2006 to withdrawn the Action of August 25, 2006 and issue a new action responsive to Applicant's amendment of July 10<sup>th</sup>. Unfortunately, and to the chagrin of Applicant, the Examiner has failed to take such action.

Consequently, Applicant is now presented with the deadline for responding to the duplicative August 25, 2006 Office Action. Therefore, Applicant files the present response, which is a duplication of the arguments filed in Applicant's amendment of July 10, 2006.

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Applicant respectfully requests, therefore, that a response now be prepared to those arguments and progress made in the prosecution of this application. Applicant regrets the potential loss of patent term and the resources associated with responding to the same Office Action twice.

Claim Status:

Original claims 19 and 20 have been cancelled previously without prejudice or disclaimer. Thus, claims 1-18 and 21 are currently pending for further action.

35 U.S.C. § 112, second paragraph:

The recent Office Action rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite. While Applicant respectfully disagrees that claim 5 was indefinite, claim 5 has nevertheless been amended herein to clarify what is being claimed. Following entry of the present amendment, claim 5 should be in clear compliance with 35 U.S.C. § 112, second paragraph, and notice to that effect is respectfully requested.

Prior Art:

In the recent Office Action, claims 1 and 4-6 were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent App. Pub. No. 2004/0116045 to Coleman ("Coleman"). For at least the following reasons, this rejection is respectfully traversed.

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Claim 1 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:  
a vibratory member configured to be vibrated by the spokes of a rotating wheel;  
and  
a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;  
*wherein said identity plate further comprises one or more panels bearing identification indicia or decorative elements, said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel attached to said main body without removing said main body from said vehicle.*  
(emphasis added).

In contrast, Coleman utterly fails to teach or suggest the claimed subject matter including one or more panels that are selectively and releasably attached to a main body that also supports a vibratory member, where the panels bear identification indicia or decorative elements.

As cited in the recent Office Action, Coleman teaches a flapper mount assembly in which "left 56 and right 54 flapper mounts are pressed together to trap one or more flappers 52."  
(Coleman, paragraph 0041 as cited by the Office Action of 4/10/06, p. 3). According to Coleman, the "flapper of the flapper mount assembly 50 extends from fork 26 inward into the path of the spokes 23 of the wheel 25 of the bicycle 28. As the wheel 25 spins during motion of the bicycle 22, the spokes 23 hit the flapper 52 and create a noise. . . . The sound is repeated at a frequency proportional to the speed of the rotation of the wheel 25." (Coleman, paragraph 0038). Consequently, the flappers 52 taught by Coleman could correspond to the claimed vibratory member recited in claim 1 that is configured to be vibrated by the spokes of a rotating wheel.

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The Office Action also cites Coleman at paragraph 0056 which states, in its entirety, the following: "The flapper mount assembly and bicycle mounting clamp enclosure assembly of the device may have other graphic treatments such as pictures, designs, patterns, geometric or non-geometric shapes, trademarks of branded products, team logos, decals, etc. added to the surface to enhance the appearance of the accessory or for advertising purposes." Thus, Coleman teaches a graphic treatment applied on the flapper mount assembly or the bicycle mounting clamp enclosure assembly.

Coleman does not teach or suggest "one or more panels bearing identification indicia or decorative elements, said panels being selectively and releasably attached to said main body such that the identification indicia or decorative elements on said vehicle can be changed by replacing a said panel." Coleman does not teach or suggest that a "graphic treatment" is applied to a panel that is selectively and releasably attached to the main body of the accessory.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claim 1 and its dependent claims based on Coleman should be reconsidered and withdrawn.

Claim 4 recites that "said vibratory member snaps into a socket on said main body." In contrast, as seen in Fig. 2, Coleman teaches a mount or guide (56) that is attached to a flapper (52) and which then slides into a channel (38) in the mounting clamp. According to Coleman, "the attachment means is by an interlock system formed by channels and structures, which mate

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with guiding channels in the bicycle mounting clamp enclosure 38.” (Coleman, paragraph 0042).

Consequently, Coleman does not teach or suggest a vibratory member that snaps into a socket on the main body as claimed. For at least this additional reason, the rejection of claim 4 should be reconsidered and withdrawn.

Claim 5 recites: “wherein said socket comprises inner and outer rings; and said vibratory member comprises a round base that is configured to snap fit between said inner and outer rings of said socket.” This subject matter is not taught or suggested by Coleman. Therefore, for at least this additional reason, the rejection of claim 5 should be reconsidered and withdrawn.

Claim 6 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:  
a vibratory member configured to be vibrated by the spokes of a rotating wheel;  
and  
a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;  
wherein said vibratory member is configured to snap into a socket on said main body at any of a variety of angles with respect to said main body so as to accommodate differently sized bicycles.

As demonstrated above, Coleman teaches a guide on the vibratory member that slides into a mating channel as shown in Fig. 2. Coleman does not teach or suggest the claimed “vibratory member is configured to snap into a socket on said main body at any of a variety of angles with respect to said main body so as to accommodate differently sized bicycles.”

In this regard, the Office Action cites to Coleman at paragraph 0055. (Action of 4/10/06, p. 4). This portion of Coleman merely discusses the distance by which the flapper extends into

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the spokes. It does not teach or suggest snapping the vibratory member into a socket at any of a variety of angles with respect to the main body as claimed. For at least these reasons, the rejection of claim 6 and its dependent claims should be reconsidered and withdrawn.

Claims 2, 3 and 7-18 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of Coleman taken alone. For at least the following reasons, these rejections are respectfully traversed.

Claim 7 recites: "The accessory of claim 6, further comprising notches disposed around a periphery of said socket for receiving tabs disposed around a periphery of said vibratory member, said notches corresponding to said variety of angles." As demonstrated above, Coleman does not teach or suggest the claimed socket. Consequently, Coleman further does not teach or suggest the claimed notches disposed around the socket corresponding to a variety of angles at which the vibratory member can be attached to accommodate differently sized bicycles.

Applicant takes this opportunity to note that, where the examiner relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). For at least these additional reasons, the rejection of claim 7 should be reconsidered and withdrawn.

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Claim 8 recites: "wherein said accessory comprises three points at which said accessory is attached to a bicycle." In contrast, Coleman teaches a single clamp 32 for securing the device to a bicycle frame. Thus, Coleman does not teach or suggest the three point attachment scheme recited in claim 8.

Applicant again notes that, where the examiner relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). For at least these additional reasons, the rejection of claims 8 and 9 should be reconsidered and withdrawn.

Claim 10 recites:

An accessory for a vehicle having a wheel with spokes, said accessory comprising:

a vibratory member configured to be vibrated by the spokes of a rotating wheel;

and

a main body supporting said vibratory member on said vehicle, said main body further comprising an identity plate;

*wherein said main body comprises an attachment point comprising a plurality of holes disposed around a periphery of a protrusion such that a zip tie can be threaded through said holes at a plurality of angles with respect to said main body.*

(emphasis added).

In contrast, as demonstrated above, the Coleman device is attached to a bicycle frame using a single clamp (32). Consequently, Coleman does not teach or suggest the claimed main

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body comprising "an attachment point comprising a plurality of holes disposed around a periphery of a protrusion such that a zip tie can be threaded through said holes at a plurality of angles with respect to said main body." For at least these reasons, the rejection of claim 10 should be reconsidered and withdrawn.

Claim 16 recites:

*A packaged kit comprising:*  
an accessory for a vehicle having a wheel with spokes, said accessory comprising;  
a vibratory member configured to be vibrated by the spokes of a rotating wheel; and  
a main body supporting said vibratory member on said vehicle,  
said main body further comprising an identity plate; and  
a variety of identification indicia or decorative elements that can be selectively disposed on said identity plate.  
(emphasis added).

In contrast, Coleman does not teach or suggest the claimed packaged kit that includes an identity plate and "a variety of identification indicia or decorative elements that can be selectively disposed on said identity plate."

Applicant again notes that, where the examiner relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). Consequently, Applicant hereby requests that prior art actually teaching the subject



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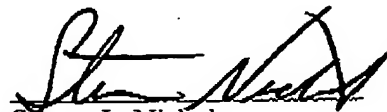
matter of claim 16 be cited on the record or the rejection of claim 16 and its dependent claims reconsidered and withdrawn.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: November 22, 2006



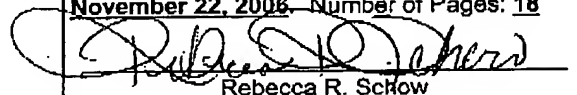
Steven L. Nichols  
Registration No. 40,326

Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095

(801) 572-8066  
(801) 572-7666 (fax)

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **November 22, 2006**. Number of Pages: **18**

  
Rebecca R. Schow